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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,979	03/11/2004	Xavier Blin	05725.1343-00	4617

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EXAMINER	
HUGHES, ALICIA R	
ART UNIT	**PAPER NUMBER**
1614	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/796,979	BLIN ET AL.	
	Examiner	Art Unit	
	Alicia R. Hughes	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *10 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-56* is/are pending in the application.

4a) Of the above claim(s) *29-35 and 44* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28, 36-43, and 45-56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date (Initial)
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 1-28, 36-43, and 45-56 are pending and the subject of this Office Action. Claims 29-35 and 44 are withdrawn from considered based upon the Applicants' response, filed on 10 October 2006.

Election/Restriction

Applicant's election in the response filed on 10 October 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the election/restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). In consideration of the foregoing, the previous restriction requirement is hereby made FINAL.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-28, 36-43, and 46-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-14, and 16-41 of U.S. Patent Publication No. 2004/0166130 [hereinafter referred to as "Filippi et al"]. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons. Most specifically, rather than referring to an oil in the cosmetic composition in addition to the resulting polyester, Filippi et al references a "pasty compound" (Page 1, claims 2). However, further limitations in the claim set make evident that the "pasty compound" has characteristics of the secondary oil of the present invention, based on the further limitation set forth in claim 18, for example. The invention of Filippi et al contain lipsticks as one of the potential end products and meets other limitations set forth in the instant application.

As stated previously, this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections – 35 U.S.C. §103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

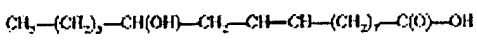
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-28, 36-43, and 45-56 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,342,527 B1 [hereinafter referred to as O'Lenick et al."] in view of U.S. Patent No. 6,491,927 B1 [hereinafter referred to as "Arnaud et al."].

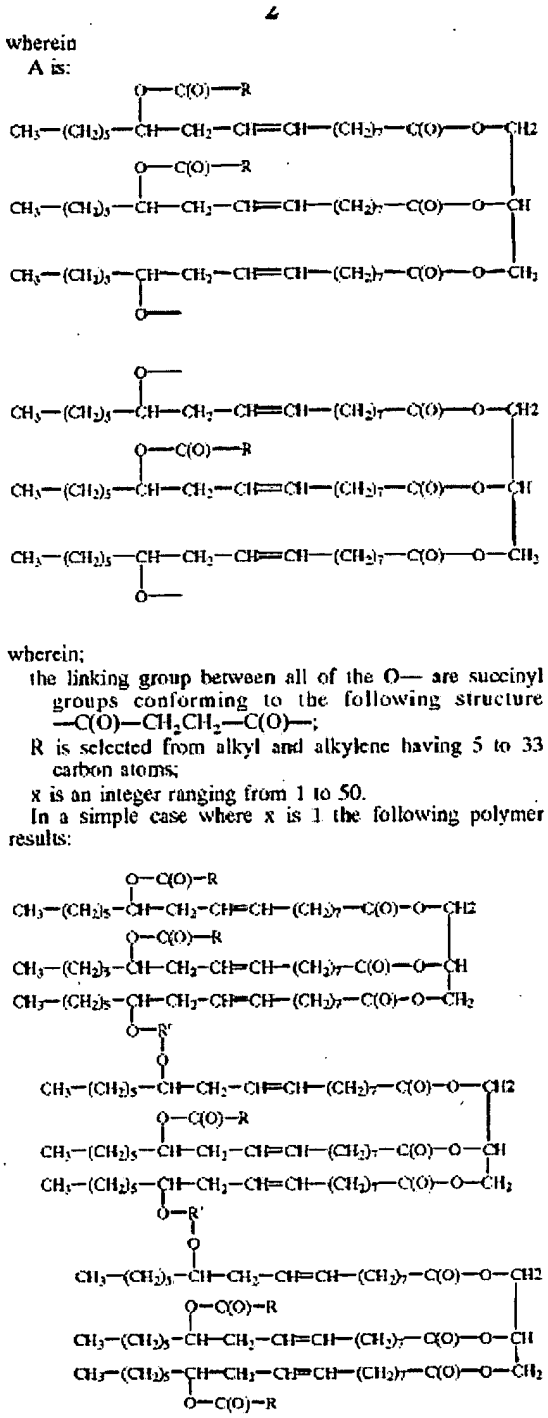
O'Lenick et al. teach a polyester and a process for providing gloss to the skin that comprises the application of an effective glossing concentration of the polyester. The compounds disclosed therein "are formulated into lipsticks and color cosmetics" (Col. 5, lines 25-27). More specifically, O'Lenick et al. teaches the esterfication of castor oil with a fatty acid

to produce an intermediate that possesses both an ester and a triglyceride function (Col. 1, lines 43-45), and further that "[t]he unique structure of castor oil coupled with the proper selection of the fatty acid and diacid chosen to make the polyester results in a product that has unique gloss when applied to the skin" (Col. 1, lines 53-55). The invention also teaches the predominant species in castor is ricinoleic acid, which has the following structural formula:



and "[i]t is this ricinoleic moiety that when linked to a guerbet alcohol in an ester gives unique gloss when applied to the skin" (Col. 3, lines 23-28 and 39-41).

The polyester taught by O'Lenick et al conforms to the following structure:

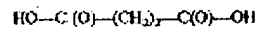


wherein
A is:

wherein;
the linking group between all of the O— are succinyl groups conforming to the following structure —C(O)—CH_2CH_2—C(O)—;
R is selected from alkyl and alkylene having 5 to 33 carbon atoms;
x is an integer ranging from 1 to 50.
In a simple case where x is 1 the following polymer results:

The polyester disclosed in O'Lenick et al. is made by esterfication of the following raw materials: (1) the triglyceride, castor oil, more specifically; (2) aliphatic monocarboxylic acids,

chosen from the list of fatty acids containing from 6 to 34 carbon atoms; and (3) an aliphatic dicarboxylic acid, more particularly, succinic acid, which conforms to the following structural formula:



(Cols. 3, line 18 and lines 55-66, col. 4, lines 1-66).

O'Lenick et al also teach that by "selecting ratios of reactants, the castor oil can be partially substituted with fatty acid leaving some unreacted hydroxyl groups. The number of remaining hydroxyl groups, and the type and concentration of diacid used to react with the unreacted hydroxyl groups, results in a controllable polyester" (Col. 1, lines 45-51).

Although O'Lenick et al. teach the polyester that is the subject of the instant invention, O'Lenick et al do not teach the polyester in a composition with an oil with a high molecular weight, or a molar mass ranging from 650 g/mol to 10000 g/mol, or the concentrations of polyester and the other oil that comprise the composition. The same, however, are taught in Arnaud, et al., among other limitations advanced as part of the present invention.

Arnaud et al teach a cosmetic composition comprising a saturated and branched C_{24} to C_{28} fatty alcohol or fatty acid ester in the form of oil at room temperature and of high molecular weight (See Abstract, p. 1) and at least one additional oil that is not the triglyceride, but holds a high molecular weight (Col. 10, lines 45-54 and col. 10, lines 36-38). Arnaud et al teach that amongst the oils of choice is hydrogenated polyisobutene (Col. 5, line 8) and that the oil can represent from 0 % to 99.9% by weight of the composition (Col. 5, lines 28-30) and likewise, the polyester can represent from 0.1% to 99.9% (Col. 10, lines 45-53 and Col. 14, lines 21-23). Arnaud et al also teach that the composition can contain colorants (Col. 3, lines 62-67 and Col. 4,

lines 1-3) and waxes, polyethylene waxes, for example (Col. 4, line 53), which "[a]fter homogenizing and milling the pigments, the mixture is cast into appropriate moulds" (Col. 6, lines 64-65).

Finally, Arnaud et al also teach a method for preparing a cosmetic composition that contains at least one polyester, at least one other oil or wax, and a colorant, which is non-sticky, non-greasy, and/or glossy when applied to the skin (Col. 11, lines 39-42, claim 17) and a method for conferring on the same "an emollient and/or film-forming and/or cohesive and adhesive nature when composition is in pulverulent form" (Col. 11, lines 53-64, claim 19).

One of ordinary skill in the art would be motivated to combine the teachings of O'Lenick et al with the teachings of Arnaud et al, due to the overlapping subject matter contained in each, most notably, cosmetic compositions containing polyesters resultant from esterfication that can be lipstick as a finished product, for example.

In consideration of the foregoing, absent any evidence to the contrary, it would have been *prima facie* obvious to one of ordinary skill in the art to combined an esterfied triglyceride which results in a polyester with another high molecular weight oil and colorant to create the presently claimed invention.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Hughes whose telephone number is 571-272-6026. The examiner can normally be reached from 9:00 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR of Public PAIR. Status information for unpublished applications is available through Public PAIR only. For information about the PAIR system, see http://pair-direct-uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

03 February 2007
ARH

Ardin H. Marschel 2/4/07
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SUPERVISORY PATENT EXAMINER